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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,872

Applicant(s)

NAKANO, TAKEHIKO

Examiner

April Y. Shan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-23 have been examined.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The disclosure is objected to because of the following informalities:

Applicant uses "another apparatus or user" frequently in the specification. It appears to the examiner sometimes, the "another apparatus or user" meaning the same "another apparatus or user" and sometimes, the "another apparatus or user" is a different "another apparatus or user".

Appropriate correction is required.

Claim Objections

4. Claims 1-23 are objected to because of the following informalities:

- a. "charges" should be "changes" in claim 10;
- b. "charging" should be "changing" in claim 21;
- c. In claims 10 and 21, the whole claim is grammatically incomprehensible;
- d. In claim 12, "the steps of" should be "steps of";

Please check the claims 1-23 and fix any informality the Applicant is aware of.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 21, recite "the maximum allowable number of times" on pages 43 and 47 lacks of antecedent basis.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-22 are directed to a content usage control method. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed steps do not result in a tangible result.

Claims 12-22 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claims 23 is directed to a computer program described in a computer readable format for causing a computer system to execute a process of controlling use of a content under a predetermined condition. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed computer program does not result in a tangible result. Claim 23 is rejected as being directed to a software does not result in a tangible result (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ansell et al. (U.S. Patent 6,792,113).

As per **claims 1 and 12**, Ansell et al. discloses a content usage control apparatus/method for controlling use of a content under a predetermined condition, comprising:

acquiring identification information of another apparatus or user requesting use of a content ("authentication server sends an information template for new machine bound passports. An information template is a collection of data specifying user-supplied data fields and prompts therefore. The information template is an XML description of the data to collect from the user... Such information can be entered by the user using conventional user-interface techniques. Processing transfers to step 810" – e.g. col. 16, lines 37-50);

registering the identification information acquired from the other apparatus or the user ("In step 810, content player 142 sends hardware identifier 140 and any user-supplied information to authentication server 126 as a request for a new machine-bound passport... Logic flow diagram 900 (fig. 9) illustrates processing by authentication server 126 (fig. 1) in response to a request for a new machine-bound passport made by content player 142 in step 810 (fig. 8)... authentication server 126 associates the new certificate with the received hardware identifier, within certificate database..." – e.g. col. 16, lines 53-67 – col. 17, lines 1-23); and

in response to the request for use of the content issued by the other apparatus or the user, determining whether the use of the content is allowed on the basis of whether the identification information of the other apparatus or the user is already registered ("content player determines whether the entered password corresponds to the full passport. If the password corresponds to the selected full passport, processing transfers to step 708 in which processing of the purchase for content continues" – e.g. col. 15, lines 13-16 and col. 15, lines 23-28; "content player determines whether hardware identifier is the hardware identifier corresponding to the machine-bound passport located by content player. If hardware identifier is the correct identifier, processing transfers from test step 714 to step 708 and the purchase process continues and any purchased content is bound to a machine-bound passport" – e.g. col. 15, lines 56-59, col. 16, lines 9-13, col. 18, lines 9-24, fig. 7 and fig. 10).

As per **claims 2 and 13**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses registration is performed in response to a request issued by another apparatus or user (e.g. logic flow diagram 718 in fig. 8 and logic flow diagram 900 in fig. 9).

As per **claims 3 and 14**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses new registration is performed only when the current number of registrations is

smaller than a predetermined maximum allowable number of registrations ("logic flow diagram by authentication server in response to a request for a new passport which includes full passport information... Typically, full passports are permitted to hold only a limited number of additional keys such that users cannot collect machine-bound keys and content from friends and colleagues without limitation. Passport key limit 1912 specifies a maximum number of keys held by a passport based upon key record. Authentication server compares the number of keys already held in the full passport of the user to the limit specified in passport key limit to determine whether the passport can include more keys" – e.g. col. 22, lines 3-48 and step 912 in fig. 9).

As per **claims 4 and 15**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses an invalidation flag (Ansell et al.'s key pair associated with hardware identifier 140 (fig. 1) corresponds to the Applicant's invalidation flag) for controlling provision of a service to a client whose identification information is already registered is stored together with identification information of another apparatus or user (e.g. col. 17, lines 24-26 and step 904 in fig. 9); and in the usage limiting step, the use of the content by the other apparatus or the user is limited, if the invalidation flag associated with the other apparatus or the user is set (col. 17, lines 26-44).

As per **claims 5 and 16**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses change limitation means/steps for limiting changing, performed by the registration means, of registered information (e.g. col. 17, lines 32-35).

As per **claims 6 and 17**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses limiting to a predetermined value, the number of times already registered identification information is replaced with identification information of another apparatus or user (e.g. col. 17, lines 32-44).

As per **claims 7 and 18**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses wherein the change limitation means limits the frequency at which already registered identification information is replaced with identification information of another apparatus or user is limited (e.g. col. 17, lines 32-39).

As per **claims 8 and 19**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses wherein when already registered identification information is replaced with identification information of another apparatus or user, the change limitation means requests the other apparatus or the user to perform a particular operation

("In addition, since the user-bound passport is not bound to any particular hardware identifier, the content and the user-bound passport can be moved from computer system to computer system and can be played back with only the effort required to enter the user's password and to view the user's private information" – e.g. col. 3, lines 40-46).

As per **claims 9 and 20**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses wherein when already registered identification information is replaced, the change limitation means requests submission of change permission information from another apparatus or a manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) "– e.g. col. 16, lines 58-61).

As per **claims 10 and 21**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses wherein the change limitation means changes depending on the maximum allowable number of times already registered identification information is changed (e.g. col. 17, lines 39-58 and col. 10, lines 60-63).

As per **claims 11 and 22**, Ansell et al. discloses a content usage control apparatus/method as applied in claims 5 and 16. Ansell et al. further discloses when the limitation on registration is changed, requesting submission of change permission information from another apparatus or a particular manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) "– e.g. col. 16, lines 58-61).

As per **claim 23**, Ansell et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Ansell et al. discloses the claimed for computer program described in a computer-readable format carrying out the method of steps.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wiser et al. (U.S. Patent No. 6,385,596) discloses a computer implemented online music distribution system provides for the secure delivery of audio data and related media.
- England et al. (U.S. Patent No. 6,327,652) discloses the identity of an operating system running on a computer is determined from an identity associated with an initial component for the operating system.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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20 October 2006
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